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REMARKS

Claims 1-22 are currently pending in the subject application and are presently under consideration. The specification has been amended herein to cure minor typographical errors; these amendments are located at pages 2-4. Further, a terminal disclaimer in compliance with 37 CFR §1.321(c) is filed concurrently with this Reply. Favorable consideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-9 for Double Patenting

Claims 1-9 stand rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,745,193. In compliance with 37 CFR §1.321(c), a terminal disclosure is filed herewith to overcome the rejection. Accordingly, this rejection should be withdrawn.

II. Rejection of Claims 1-16 and 20-22 Under 35 U.S.C. §102(e)

Claims 1-16 and 20-22 stand rejected under 35 U.S.C. §102(e) as being anticipated by Ford *et al.* (US 6,510,424). Reversal of this rejection is requested for at least the following reasons. Ford *et al.* does not disclose each and every limitation set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim.* *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim.* *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Applicants' claimed invention relates to a system and method to facilitate configuring and tuning of a plurality of parameters within a notification system, wherein parameters are employed to personalize notification capabilities of the notification system. Independent claims 1, 14 and 20 recite similar claim limitations, namely: a

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profile definition and selection system that receives *contextual information relating to a current user state*, the profile definition and selection system *generating and/or relaying a set of control parameters based at least partially upon the contextual information*; and a notification manager that selectively sends a user at least one of a notification and a communication based upon the set of control parameters. In particular, the invention as claimed utilizes a profile definition and selection system to receive contextual information relating to a current user state. The profile definition and selection system (based at least partially upon the received contextual information relating to the current user state) generates and/or relays a set of control parameters to a notification manager that selectively sends a user at least one of a notification and a communication based on the set of control parameters received from the profile definition and selection system. Ford *et al.* does not disclose these exemplary aspects of the claimed invention.

Ford *et al.* relates to an electronic notification agent, and in particular to an agent for processing calendar information for use in a portable data processing device. More particularly, the cited document provides that an intelligent agent resides in a server-based synchronization engine whereupon the synchronization engine performs a method to allow a handheld device to retrieve data directly from a server without requiring a desktop or laptop data processing system. The Office Action contends that Ford *et al.* discloses a profile definition and selection system at col. 3, line 20-col. 4, line 34. Applicants' representative however avers to the contrary.

Col. 3, line 20-col. 4, line 34, discloses a storage device that includes a calendar program, an electronic agent, and a user profile wherein the electronic agent runs on a periodic basis to query whether new calendar documents that have an originator different from the owner of the calendar database have been received, and if so, the agent forwards the calendar data to a specified user. Alternatively, the noted passage provides that the agent can operate with a server-based synchronization engine that allows a handheld device, such as a Palm top, to retrieve data directly from the server without requiring a desktop or laptop system. In addition, the indicated passage discloses that the system provides the user a method to specify the data to be forwarded and the time parameters within which to check the storage device.

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The cited passage however, is silent regarding the profile definition and selection system recited in independent claim 1. In particular, the cited document is silent regarding the fact that the profile definition and selection system receives contextual information relating to a current user state, and further that the profile definition and selection system generates and/or relays a set of control parameters based in part upon the contextual information received. All that Ford *et al.* discloses is that a user profile is utilized to specify the data to be forwarded and the time parameters within which to check the storage device for the data specified. Therefore it is clear that Ford *et al.*, rather than basing decisions on contextual information relating to a current user state, is basing decisions on the state of the data specified by the user in a user profile. Consequently, since Ford *et al.* does not utilize contextual information relating to a current user state, but rather utilizes the state of specified data, the cited document cannot conceivably be generating and/or relaying a set of control parameters based in part on the contextual information relating to a user state. Accordingly, reversal of the rejection with respect to independent claims 1, 14 and 20, and associated dependent claims, is respectfully requested.

III. Rejection of Claims 17-19 Under 35 U.S.C. §103(a)

Claims 17-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ford *et al.* (US 6,510,424) in view of Breed *et al.* (US 6,735,506). This rejection should be withdrawn for at least the following reasons. Ford *et al.* and Breed *et al.*, either alone or in combination, fail to teach or suggest each and every limitation recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to*

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make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As stated above, the invention as claimed relates a system and method to facilitate configuration and tuning of a plurality of parameters within a notification system, wherein parameters are employed to personalize notification capabilities of the notification system. Independent claim 17 recites: an adaptive component that *automatically tunes one or more parameters* by collecting feedback about notification behavior during a training phase; and a notification manager that selectively sends a communication based upon the behavior. In particular, applicants' claimed invention utilizes an adaptive component to automatically tune parameters based on feedback related to notification behavior collected during a training phase. Neither Ford *et al.* nor Breed *et al.*, either individually or in combination, teach or suggest these novel aspects of the claimed invention.

As the Office Action concedes, Ford *et al.* is silent regarding an adaptive component that automatically tunes one or more parameters by collecting feedback about notification behavior during a training phase, and thus attempts to rely on Breed *et al.* to rectify this deficiency. Breed *et al.* is related to (i) methods and apparatus for sensing and determining the status of occupants in a vehicle prior to, during and/or after an accident or deployment of an airbag and transmitting data relating to the occupants to a remote facility such as an emergency response station; and (ii) methods and apparatus for diagnosing components in a vehicle and transmitting data relating to the diagnosis of the components in the vehicle and other information relating to the operating conditions of the vehicle. (See col. 3, lines 9-19). Breed *et al.* however, fails to teach an adaptive component that automatically tunes parameters related to notification behavior during a training phase.

The Office Action indicates that support for its contention that Breed *et al.* teaches or suggests the adaptive component recited in independent claim 17 may be found at col. 22, lines 15-35 and col. 23, lines 35-67. Applicants' representative respectfully disagrees. Col. 22, lines 15-35 and col. 23, lines 35-67 disclose that a

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diagnostic module, that may comprise a neural network pattern recognition facility, compares data patterns received from each sensor individually, or in combination with data from other sensors, with patterns for which the diagnostic module has been trained to determine whether the component is functioning normally or abnormally. In contrast, the invention as claimed, utilizes an adaptive component to tune parameters related to notification behavior based on the feedback of notification behavior received during a training phase. Thus, it is submitted that applicants' claimed invention is clearly distinguishable from Breed *et al.*, as the adaptive component recited in independent claim 17 is utilized to tune parameters related to notification behavior, whereas the diagnostic component disclosed in Breed *et al.* is used to determine whether a component is functioning normally or abnormally.

Further, applicants' representative asserts that there is insufficient motivation to impel one of ordinary skill in the art to combine Ford *et al.* and Breed *et al.* to result in the purported combination. Ford *et al.* relates to the computer arts, whereas Breed *et al.* clearly pertains to automotive telematics and thus to the non-analogous automotive arts. Thus, since both Ford *et al.* and Breed *et al.* do not reside in the same, or even similar, art groups, applicants' representative believes that the Office Action is attempting to utilize an impermissible 20/20 hindsight analysis to reject the subject claims, *e.g.*, it is believed that the rejection is being based on an assertion that it would have been obvious to do something not suggested in the art based on the advantages disclosed in the applicants' specification. This sort of rationale has been condemned by the CAFC as being sophistic; *see e.g. Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In view of at least the foregoing, it is respectfully requested that this rejection be withdrawn and that independent claim 17 (and claims that depend there from) be placed in condition for allowance.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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